

### III. REMARKS

1. Applicant notes that there are 19 claims pending in this application. Claims 1 and 17 are independent claims. (See Examiner's comments 1 and 2).

2. With respect to the Examiner's objection to the drawings, Applicant respectfully notes that FIG. 4 does not include the terms referenced by the Examiner.

FIG. 4 does not include reference 404.

Reference 502 of FIG. 5 is referred to on page 38, line 8, and only designates a page.

Reference 504 of FIG. 5 is referred to on page 38, line 7.

3. With respect to the Examiner's objection to the specification, Applicant respectfully notes that the cited informalities are not found in the filed specification.

4. Claims 1-3, 6, 9, 11, 13 and 15 are not unpatentable over Johnston et al. ("Johnston") and Uhler et al. ("Uhler") under 35 U.S.C. §103(a).

Neither Johnston and Uhler disclose or suggest a method, for use in a user system, of generating an hyperlinked physical copy of an electronic document comprising one or a plurality of hyperlinks, said method comprising the steps of selecting an electronic document, creating an hyperlink table, associating said hyperlink table with a physical copy of said electronic document, said physical copy comprising one or a plurality of pages, for each page of the physical copy, identifying in the

electronic document, the one or plurality of hyperlink items comprised in the page, storing in the hyperlink table an identification of each identified hyperlink item, retrieving from the electronic document identification and location of information and/or service associated with each identified hyperlink item on the page, storing in the hyperlink table said identification and location of information and/or service associated with each identified hyperlink item, retrieving from the electronic document, electronic coordinates of each identified hyperlinked item on the page, translating said electronic coordinates into physical coordinates on the page of the physical copy, storing said physical coordinates in the hyperlink table, as recited in claim 1.

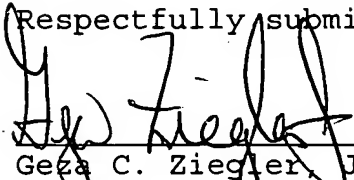
Thus, claims 1 and 17 are allowable. Claims 2-16 and 18-19 should be allowable by reason of their respective dependencies.

5. The other art cited by the Examiner similarly does not disclose or suggest Applicant's invention and claims 1-19 should be allowable.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 50-0150.

Respectfully submitted,

  
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30 November 2004  
Date

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I hereby certify that this correspondence is being deposited with the United States Postal Service on the date indicated below as first class mail in an envelope addressed to MAIL STOP AMENDMENT, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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